

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Olsen et al.

Confirmation No: 4622

Serial No.: 10/558,628

Group Art Unit: 1651

Filed: July 13, 2006

Examiner: T. Underdahl

For: Mash Viscosity Reduction

PETITION UNDER 37 C.F.R. 1.181 TO WITHDRAW FINALITY OF OFFICE ACTION

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition to withdraw the finality of the office action mailed July 27, 2007 (hereinafter "the second office action") in the above-identified application. The second office action withdrew all rejections set forth in the initial office action mailed December 18, 2006 (hereinafter "the initial office action"), but made a new rejection under 35 U.S.C. 103(a). The second action states that the new rejection was necessitated by Applicant's amendment. This is respectfully traversed.

The claims which were pending prior to the initial office action were claims 13-24. Claim 13, the sole independent claim, reads as follows:

13. A method of producing ethanol, said method comprising the steps of:
 - a. providing a mash comprising a starch containing material and water;
 - b. preliquefying the mash of step (a) in the presence of a beta-glucanase;
 - c. gelatinizing the mash of step (b) by jet cooking;
 - d. liquefying the mash of step (c) in the presence of an alpha-amylase, a beta-glucanase and a xylanase; and
 - e. saccharifying and fermenting the mash of step (d) to produce ethanol.
 - f. recovering the ethanol.

The initial office action included a rejection of claims 13-16 and 18-24 under 35 U.S.C. 103 as being unpatentable over LaRoye et al. (WO 97/42301) in view of Antrim (U.S. Patent No.

5,180,669) and Wang (Cellulose Degradation, 2001) with support from Thompson et al. (U.S. Patent No. 6,468,355).

In the response to the initial office action filed July 13, 2007, Applicants canceled claims 13-24 and added claims 25-46. Claim 25, the sole independent claim, reads:

Claim 25 (New). A method of producing ethanol, comprising the steps of:

- (a) preliquefying a mash comprising a starch containing material and water in the presence of a beta-glucanase to form preliquefied mash;
- (b) gelatinizing the preliquefied mash by jet cooking to form gelatinized starch;
- (c) liquefying the gelatinized starch in the presence of an alpha-amylase, a beta-glucanase and a xylanase to form dextrin;
- (d) saccharifying the dextrin to form saccharide;
- (e) fermenting the saccharide of step (d) to produce ethanol; and
- (f) recovering the ethanol.

Except for the elimination of step a recited in claim 13, the scope of claims 13 and 25 is identical. Furthermore, the absence of step (a) is not the reason that the new claims are subject to a new ground for rejection under 35 U.S.C. 103. Rather, the 103 rejection set forth in the initial office action was withdrawn after Applicants argued that it was improper to combine Wang with the other cited references (Laroye et al., Antrim and Thompson et al.). Therefore, Applicants' amendment did not necessitate the new rejection.

For the foregoing reasons, Applicants submit that it was improper for the Office to make the second office action "final" and therefore request withdrawal of the finality of the second office action.

Respectfully submitted,

Date: September 25, 2007

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